

### **REMARKS**

The office action of February 8, 2006 has been reviewed and these remarks are responsive thereto. Claims 1 and 4-9 are pending in the application. By this amendment, claims 8 and 9 have been amended for editorial purposes to correctly recite a wireless telephone in accordance with their base claim (independent claim 7).

Reconsideration and allowance of the instant application are respectfully requested.

#### *Request to Withdraw Finality of the office action*

Applicants are filing herewith a request to withdraw the final status of the office action. As agreed with Examiner Peaches during a teleconference on April 6, 2006, the office action was improperly designated as 'final' due to U.S. patent no. 5,953,541 to King et al. (King) and U.S. patent no. 6,528,741 to Walker (Walker) being applied as new grounds of rejection to claims 1 and 4-9, which were not necessitated by Applicant's amendment or based on information cited in a recently submitted information disclosure statement. During the interview, Examiner Peaches requested that we treat the office action as 'non-final' and file a formal request to withdraw its final status, which is filed herewith.

#### *Double patenting*

Applicant respectfully requests acknowledgement of the terminal disclaimer filed on August 29, 2005.

#### *Non-responsive Office Action / Copy of Response to Arguments from the November 3, 2004 office action*

The office action appears to be non-responsive; as it is largely a copy of the office action mailed November 3, 2004 and it fails to address many of the claim amendments and arguments pertaining to King and Walker provided in the after-final amendment filed on January 21, 2005 and requested to be considered via the RCE filed on February 28, 2005. Moreover, the Response to Arguments portion of the outstanding office action appears to be a verbatim copy of the Response to Arguments portion of the November 3, 2004 office action and thus fails to address

the amendments and arguments pertaining to King and Walker submitted since November 3, 2004.

Accordingly, if the Patent Office chooses to reapply King in view of Walker to the pending claims after substantively considering the RCE amendments and arguments and the comments provided below, Applicant respectfully submits that such an office action should be non-final to provide Applicant with a bona fide opportunity to respond.

*35 U.S.C. §103 rejections*

Claims 1 and 4-9 stand rejected under 35 USC §103(a) as allegedly being unpatentable over King in view of Walker. Reconsideration and allowance of these claims is respectfully requested.

Claims 1 and 4

Claim 1 recites, *inter alia*, the subject matter of a method of entering individual characters into a text string using a non-ambiguous word editor of a wireless telephone with a keypad, in which the step of scrolling by the user includes the user scrolling through the characters step by step using another key of the keypad that becomes dedicated for scrolling when the wireless editor is in an editor mode. At least this subject matter is not taught or suggested by the prior art of record.

The office action correctly notes, “King also fails to disclose wherein a one of the alphanumeric keys become dedicated for scrolling.” The office action relies upon Walker for this deficiency of King.

However, Walker also fails to disclose at least this claimed subject matter of independent claim 1. Walker discloses a portable electronic device that has a plurality of single contact keys (2) and a multi-way shift key (3). A user can enter a primary character using a contact key alone (e.g., 0 ... 9, \* and #) (col. 2, lines 13-14) or can enter “additional ‘secondary’ characters, for example, alphabetical characters, punctuation and symbols may be selected for entry by engaging in combination one of the four switch contacts of the first key 3 and the single switch contact of one of the plurality of second keys 2.” *Id.* at lines 16-20. Thus, in concert with shift key (3), each contact key of Walker can enter four secondary characters. *Id.* at lines 32-47.

Walker simply teaches that each switch contact can enter secondary characters along with a primary character via the use of directional shift key (3). There is no teaching in Walker

whatsoever of the claimed subject matter of permitting a user to scroll through characters step by step using another key of the keypad that becomes dedicated for scrolling when the wireless editor is in an editor mode. For at least this reason, Applicant respectfully submits that independent claim 1 and claim 4 depending therefrom are allowable over King in view of Walker.

#### Claims 5 and 6

Independent claim 5 recites, *inter alia*, the subject matter of a text-editing terminal having a scroll key,

wherein the scroll key is one of the alphanumeric keys and becomes dedicated for scrolling when said terminal is in an editor mode, the scroll key enables scrolling of the different characters associated with each occurrence of a keystroke of an alphanumeric key following the pressing and release of each said alphanumeric key.

As noted above with respect to independent claim 1, neither King nor Walker, either alone or in combination, disclose the claimed subject matter of a scroll key that becomes dedicated for scrolling when the terminal is in an editor mode.

In addition, the office action fails to provide a *prima facie* basis for rejecting claim 5 over King in view of Walker in view of the RCE amendment nor does it even address the claimed subject matter added in the RCE amendment of “enabling scrolling ... with each occurrence of a keystroke ... following the pressing and releasing of each alphanumeric key.” The cited prior art simply fails to teach or suggest this claimed subject matter of independent claim 5 and was not relied upon to do so.

For at least these reasons, Applicant respectfully submits that independent claim 5 and claim 6 depending therefrom are allowable over the prior art of record.

#### Claims 7-9

Independent claim 7 includes subject matter similar to the subject matter discussed above with respect to independent claim 5. For at least the reasons discussed above, Applicant

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respectfully submits that independent claim 7 is allowable over the cited prior art, as well as claims 8 and 9 depending therefrom.

*Conclusion*


Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number.

Respectfully submitted,

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